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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/040,459	01/09/2002	Francis Emmerson	367.40990X00	2640
20457	7590	05/05/2004		
ANTONELLI, TERRY, STOUT & KRAUS, LLP 1300 NORTH SEVENTEENTH STREET SUITE 1800 ARLINGTON, VA 22209-9889				
			EXAMINER CAPRON, AARON J	
			ART UNIT 3714	PAPER NUMBER

DATE MAILED: 05/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/040,459

Applicant(s)

EMMERSON, FRANCIS

Examiner

Aaron J. Capron

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 18-30, 32-34 and 37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18-30, 32-34 and 37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

This is a response to the Amendment received on March 1, 2004, in which claims 18, 24, 27, 30, 33-34 were amended, claim 37 was added, and claims 31 and 35-36 were cancelled. Claims 18-30, 32-34 and 37 are pending.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 18-21 and 25-30, 32-34 and 37 rejected under 35 U.S.C. 102(b) as being clearly anticipated by Schneier et al. (U.S. Patent No. 5,871,398; hereafter "Schneier").

Schneier discloses a client server system, comprising a client terminal and a server (Figure 1), wherein the client terminal and the server are remote from one another, the client terminal and server being operable in and switchable between an on-line connected mode and an off-line disconnected mode (abstract), wherein in the connected mode the client terminal and server are connected to another through a communication link such that data is exchangeable therebetween (Figure 1, items 26 and 92) and in the off-line disconnected mode the client terminal and server are disconnected from one another (Figure 1), and wherein the server comprises memory for storing game data that defines an electronic game and encrypts the game data in accordance with one or more predetermined operational parameters (Figure 3), and the communication link transmits the encrypted game data to the client terminal during an on-line

connected mode session, and wherein the client terminal comprises a memory for storing received encrypted game data (Figure 6), a processor for executing the encrypted game data so as to provide for playing of the electronic game during an off-line disconnected mode session and to provide an outcome of the gameplay, and the communication link transmits the outcome to the server during an on-line connected mode session (4:47-5:23).

The Arguments presented below are incorporated into the above rejection.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schneier in view of Khan et al (U.S. Patent No. 6,029,046; hereafter "Khan").

Referring to claims 22-23, Schneier discloses a client/server system, but does not disclose a time limit for completing a game. However, Khan discloses that a player has a time limit to complete a game (2:13-29; 11:15-15:38 and 20:49-21:55). One would be motivated to combine the references in order to charge players for the amount of time played since the games are so expensive to purchase (Khan 1:33-42). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a time limit of Khan into the gaming system of Schneier in order to charge players for the amount of time played since the games are so expensive to purchase.

Referring to claim 24, Schneier in view of Kahn disclose that if the game is reset then a null game is encrypted and returned to the server (2:66-3:5).

The Arguments presented below are incorporated into the above rejection.

### ***Response to Arguments***

Applicant's arguments filed March 1, 2004 have been fully considered but they are not persuasive.

Applicant argues that Schneier is limited since the CMC determines the results of plays in the game of skill and that the processor within Schneier fails to process the results of the user actuated game play. However, Schneier discloses an embodiment having an off-line arrangement since there is no need to have an on-line connection between the HTV and the CMC while the games are being played (22:54-60). The Applicant must consider how a user can play an off-line game at Schneier's client terminal without having the client terminal processing the results of the user-actuated game. Therefore, the claimed invention fails to preclude the Schneier's invention.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron J. Capron whose telephone number is (703) 305-3520. The examiner can normally be reached on M-Th 8-6.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on (703) 308-1806. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ajc

  
JESSICA HARRISON  
PRIMARY EXAMINER